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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,998	03/27/2001	Ronald P. Sansone	E-984	2015

919 7590 10/24/2003

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/817,998

Applicant(s)

SANSONE, RONALD P.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7-31 of copending Application No. 09/818,800.** Although the conflicting claims are not identical, they are not patentably distinct from each other because the present

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application contains an obvious variation recitation in claim language as applied to the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-2, 9-10, 15-16, 19-21 and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuebert et al. (US 2002/0165729).**

Kuebert et al. teach a method and system for flexible mail delivery, comprising:

As per claims 1, 19-21 and 23-25,

depositing with the carrier mail containing the recipient's name and physical address and the sender's name and address [0039];

capturing the name and physical address of the recipient and the sender [0020];  
[0026]; [0031];

translating the name and physical address of the recipient into a telephone number [0022]; [0029];

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utilizing the telephone number of the recipient to inform the recipient of the availability of the deposited mail [0036]; [0038];

notifying the carrier of the manner in which the recipient would like the mail delivered [0043];

delivering mail to the recipient in the manner specified by the recipient to the carrier [0048]; [0050].

Also, Kuebert et al. teach:

As per claims 2 and 9, said method and system, wherein the recipient notifies the carrier to deliver the mail to a specified name and address [0009]; [0043].

As per claim 15, said method and system, further including the step of: informing the sender of the delivery of the mail [0042].

As per claims 10 and 16, said method and system, wherein the recipient notifies the carrier to hold the mail for a specified period of time [0043].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3, 11 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al.**

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As per claim 3, Kuebert et al. teach said method and system, wherein the recipient notifies the carrier to deliver the mail to a specified name and address [0009]; [0043].

Kuebert et al. do not specifically teach that the specified address includes the sender address.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kuebert et al. to include that that the specified address includes the sender address, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Kuebert et al. would perform the invention as claimed by the applicant with the specified address being of any type.

As per claim 11, Kuebert et al. teach said method and system, wherein the recipient notifies the carrier to change the delivery time [0043].

However, Kuebert et al. do not specifically teach that changing the delivery time includes a slower or faster delivery method than that paid for by the sender.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kuebert et al. to include that changing the delivery time includes a slower or faster delivery method than that paid for by the sender, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Kuebert et al. would perform the invention as claimed by the applicant with either specifying a slower or faster delivery method, or not.

As per claim 27, Kuebert et al. teach all the limitations of claim 27, including that the recipient is notified by a telephone, except that the recipient is visually impaired.

Official notice is taken that it is well known in the art that visually impaired people often prefer audio communication means rather than visual.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kuebert et al. to include that the recipient is visually impaired, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Kuebert et al. would perform the invention as claimed by the applicant with either specifying that the recipient is visually impaired, or not.

**Claims 4-8, 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al. in view of Srinivasan (US 6,072,862).**

As per claims 4-8, Kuebert et al. teach all the limitations of claims 5-8, except for informing the carrier to e-mail or send by facsimile the contents of the mailpiece to one or more specified e-mail addresses.

Srinivasan teaches a method and system for adaptable message delivery, wherein the recipient can select the preferred way of getting the mail; said method includes informing the carrier to e-mail or send by facsimile the contents of the mailpiece to one or more specified e-mail addresses (column 2, lines 37-58; column 3, lines 4 – column 4, line 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al. to include informing the carrier to e-mail or

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send by facsimile the contents of the mailpiece to one or more specified e-mail addresses, because it would allow the recipient to access all his messages via one message accessing means regardless the form said messages were sent to, as specifically stated in Srinivasan (column 4, lines 56-65).

Also, as per claim 4, the “open the mail” feature is obvious for allowing conversion of one media format to another.

As per claim 13, Srinivasan teaches said method and system, wherein the term “subscriber” obviously indicates charging the recipient for delivering mail to the recipient (column 2, lines 37-58).

As per claim 26, Srinivasan teaches said method and system, wherein the recipient notifies a data center who notifies the carrier of the manner in which the recipient would like the mail delivered (column 2, lines 37-58; column 3, lines 4 – column 4, line 7).

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al. in view of Sherwood et al. (US 6,542,584).**

As per claim 12, Kuebert et al. teach all the limitations of claim 12, except for charging the recipient for receiving notification of the availability of the deposited mail.

Sherwood et al. teach a method and system for automatic voice mail redirection, wherein a recipient is charged a fee for receiving a notification that a voice mail message is left for the recipient (column 1, lines 10-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al. to include charging the recipient for



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receiving notification of the availability of the deposited mail, because it would generate funds for business to operate.

**Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al. and Sherwood et al. in view of Srinivasan.**

As per claim 14, Kuebert et al. and Sherwood teach all the limitations of claim 14, except for charging the recipient for delivering mail to the recipient.

Srinivasan teaches siad method and system for adaptable message delivery, wherein the term "subscriber" obviously indicates charging the recipient for delivering mail to the recipient (column 2, lines 37-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al. and Sherwood to include charging the recipient for delivering mail to the recipient, because it would generate funds for business to operate.

**Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al. in view of McKeen, Jr. (US 4,037,956).**

As per claim 17, Kuebert et al. teach all the limitations of claim 17, except that the recipient notifies the carrier to destroy the mail.

McKeen, Jr. teaches a method and apparatus for verified mail system, wherein the verified content of the recipient mail is destroyed if the recipient does not want to keep it stored (column 2, lines 28-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al. to include that the recipient notifies the

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carrier to destroy the mail, because it would decrease the expenses for handling mail for the post office.

**Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al. and Srinivasan in view of Gordon et al. (US 6,289,323).**

As per claim 18, Kuebert et al. and Srinivasan teach all the limitations of claim 18, including sending the contents of the mailpiece to one or more specified e-mail addresses, except that the recipient notifies the carrier to recycle the material comprising the mail.

Gordon et al. teach a method and system for a mail delivery including sending the contents of the mailpiece to one or more specified e-mail addresses, wherein the mailpiece (a postcard) is recycled (column 15, lines 63-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al. and Srinivasan to include that the recipient notifies the carrier to recycle the material comprising the mail, because it would decrease the expenses for handling mail for the post office, and allow to save natural resources.

**Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al. in view of Busch et al. (US 6,390,921).**

As per claim 22, Kuebert et al. teach that the recipient is notified via e-mail and a website of the availability of the deposited mail [0036]; [0043].

Kuebert et al. do not specifically teach that the recipient is notified via television of the availability of the deposited mail.

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Busch et al. teach a method and system for sharing information in a network environment, wherein a user can receive a message via e-mail, or Web-TV, or telephone, or regular mail delivery (column 4, lines 38-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al. to include that the recipient is notified via television, because it would allow to combine the notification service with other TV or WEB related programs, thereby make it more attractive to the customers.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

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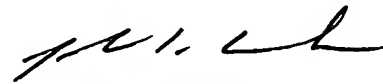
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**(703) 872-9306** [Official communications; including After Final  
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

IB



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